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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,377	07/29/2003	Minoru Inuzuka	116627	4326

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EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,377

Applicant(s)

INUZUKA ET AL.

Examiner

Margaret Einsmann

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-3, 6, 7 and 12 is/are rejected.
- 7) ☐ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/15/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7 and 12, drawn to a dyeing process, classified in class 8, subclass 471.
- II. Claims 8-11, drawn to a device, classified in class 156, subclass 540.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process could be performed by hand or by the device of US 6,520,999. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

During a telephone conversation with Julie Seaman, # 51156, on 12/22/04 a provisional election was made with traverse to prosecute the invention of Group I,

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claims 1-7, and 12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamata et al. (Nidek Co., Inc), EP 0 982,432 A2.

Kamata et al. disclose a applicant's process of dyeing lenses in a vapor deposition device wherein a lens holding device holds a pair of lenses at a distance from a base body in a vapor deposition device so that the dye may be sublimed onto the lens surfaces without contact of the lens with the base body or the heating device. A process of placing a lens in a vacuum vapor deposition device as claimed, placing a base body having a dye application area to which a sublimatable dye has been applied as claimed, so that the dye application area faces a surface of the lens to be dyed as

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claimed; and heating the base body in the vapor deposition device to sublimate the dye, depositing the sublimed dye on the lens as claimed is disclosed. See figure 5 for the steps as claimed in claims 1 and 2, [0008] in col 2 for the first three steps; [0064] in col 9 for the fourth step as claimed in claim 2 wherein the lens is heated under atmospheric pressure to fix the dye on the lens. The reference differs from the claims because patentee does not disclose or claim restraining the rise in temperature of the lens while the vapor deposition device is heated under almost a vacuum. Example 1 in column 10 is a working example which teaches the claimed process. In [0069] print base body 3 is dried and attached to the underside of support plate 12. See figure 2. The lenses 14 are mounted on lens holders 13 having a height of 15 mm. The heater 15 is turned on and the pressure is reduced to 10 mm Hg (which is almost a vacuum as claimed). The support shaft 11 is operated to move the support plate 12 downward until the print base body 3 attached to the underside of plate 12 comes into contact with the heater 15 to thereby start sublimation of the dye of the colored layers 2. See figure 4A. The lens 14 is on the opposite side of the base body 33 from the halogen lamp 23. It would have been obvious to a person having skill in the art of dyeing lenses at the time the invention was made that at all times there is no contact of the lenses with the base body or with the heater, and accordingly, the space (air molecules) between the lens surface and the base body inherently restrains the rise in temperature of each of the lenses as the dye is sublimated onto the lenses under almost a vacuum.

Claims 7,8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamata et al as applied to claim 1-3 above, and further in view of Suzuki et al, US

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4,211,823. Kamata et al. is relied upon as set forth in the above rejection as teaching applicant's process of dyeing lenses in a vapor deposition device wherein a lens holding device holds a pair of lenses at a distance from a base body in a vapor deposition device so that the dye may be sublimed onto the lens surfaces without contact of the lens with the base body or the heating device. Kamata differs from the instant claims in that he does not disclose dyeing a lens onto which a hard coat had been applied, said hard coat comprising tetrafunctional silane in a solid contents of 30% or less by weight.

Suzuki teach a tintable coating composition comprising hydrosylates of silane comprising, preferably the tetrafunctional silane of formula 2.1 in col 2 lines 17-21. The amount used is more than about 10, which meets applicant's limitation that there must be less than about 30% by weight of solid content of tetrafunctional silane. See col 3 lin3w 13 et seq. Articles advantageously coated with this coating composition include plastic lenses such as sunglasses and ophthalmic lenses including diethylene glycol bisallyl carbonate, which is the lens dyed in Kamata's example 1 (CR-39). See col 4 lines 33-49. In column 6 a plastic lens coated with the coating composition of tetrafunctional silane was dyed with disperse dyes in a dipping method.

It would have been obvious to a man having skill in the art at the time the invention was made to dye the coated lens of Suzuki using the method of Kamata et al because Kamata et al teach that their method has been developed to overcome the problems of the conventional dip dyeing method of dyeing lenses, for example disposal of waste [0003] and unevenness of hue, high humidity and high temperature working environment. [0004]

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 6-7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "restraining a rise in temperature of the lens" is vague and indefinite because it states a result without stating a method step of obtaining that result. The examiner suggests that the limitation of claim 4 be inserted into claim 1. In claim 3 the limitation contained in lines 2-5 is not clear and is vague and indefinite. Additionally, what is a "predetermined color difference?"

Allowable Subject Matter

Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4 and 5 are allowable over Kamata et al. because Kamata's process does not include a positive step of cooling the vapor deposition device to restrain the rise in temperature of the lens while the dye is being sublimated onto the lens as claimed. It does, however, include the step of releasing the vacuum and removing the lens from

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the vapor deposition device, thus cooling the lens before the lens is heated to fix the dye on the lens.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/27/04


Margaret Einsmann
Primary Examiner
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